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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,399	10/16/2001	Tatsuya Kawahara	77661/57	3063

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EXAMINER

HODGE, ROBERT W

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,399

Applicant(s)

KAWAHARA ET AL.

Examiner

Robert Hodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-21,23-29 and 31-39 is/are pending in the application.
4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 4, 10, 13, 16, 19, 25, 29, 34 and 37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2,3,6-9,11,12,14,15,17,18,20,23,24,26-28,31-33,35,36,38 and 39.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/9/05 have been fully considered but they are not persuasive. The examiner respectfully submits that although claims 1, 4, 10 and 29 have been amended to add further limitations to the claim, the limitations are the same as those found in other claims and therefore the prior art reads on the amended claims as so recited. Therefore all prior art rejections will be maintained from the previous office action.

2. In regards to applicants' arguments over claims 1, 10 and 25, Kato does list multiple layers for the water-repellent layer, but does not specifically say it is multi layered. However the disclosure of the different specific layers by Kato reads on the claims as so recited.

3. In regards to applicants' arguments over claim 4, because open claim language is used a woven cloth reads on the claimed filament of claim 4.

4. In regards to applicants' arguments over claims 10 and 29 the Kato reference lists multiple resins that can be used as binders and each resin has different adhesiveness because they have different molecular structures. And if the order of use is invariant then that would be a statement of intended use, which is given little to no patentable weight.

5. In regards to applicants' arguments over claims 34 and 37, these claims are product by process claims, therefore the process limitations are given little to no patentable weight if the structure can be found, which is disclosed by Kato.

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6. In regards to applicants' arguments over claims 13 and 16, Campbell et al. discloses a fiber mat, which is woven and therefore reads over the claims as so recited.
7. In regards to applicants' arguments over claim 19, because no specific amounts are disclosed and the limitations are broad and vague the Beattie et al. reference reads on the claim as so recited.
8. The examiner notes that claims 5, 22 and 30 have been canceled.
9. The objection to the specification is withdrawn in light of the submitted amendment, which overcomes the rejection.
10. The rejection of claims 1 and 4 under 35 U.S.C. 112, second paragraph is also withdrawn in light of the amendments to the claims.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

((b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 1, 4, 10, 25, 29, 34 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato JP 10261421 (U.S. Patent No. 6,127,059 is used as the English translation) hereinafter referred to as Kato.

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13. Kato teaches a diffusion layer with at least a base layer (abstract lines 1-2) that has a water-repellent layer (abstract line 15, column 3, line 13 and column 4 line 15 et seq). Kato also teaches "a carbonized yarn of woven fabric [column 3, lines 39-42 and lines 46-47], and a carbonized binder impregnated into the yarn [column 4, lines 15 et seq]". It is inherent that a binder that is impregnated into a woven yarn would connect the filaments of the yarn together. Kato further teaches a non-woven base layer (column 6, lines 51 and 66) with a synthetic resin binder impregnated into it (column 5, lines 50-52), it being pressed (column 5, line 9) and carbonized (column 3, lines 39-42 and lines 46-47). Kato also teaches a base layer having opposite surfaces (column 6, line 34 and claim 6), that the water-repellent layer is a mixture of carbon and synthetic resin (column 4, lines 15-16 and claim 4), and that the water-repellent layer is multi layered (column 1, lines 15 et seq). It is inherent that multiple layers would have different adhesive properties especially if they are applied to the substrate under different conditions such as disclosed by Kato (column 1, lines 29-31 or column 6 lines 4-8). Kato further teaches the use of two kinds of binders (column 4, lines 50-56). The examiner notes that of the materials disclosed by Kato, the order of use determines which material will have a higher rigidity. The examiner notes that the use of the phraseology "higher rigidity" is relative to the materials at hand and can change with any reference. And since there is no recitation in claim 29 what a first or second material would be, the Kato reference reads on the claim as so recited. The examiner further notes that all of the materials listed in the Kato reference have some sort of

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adhesive properties. Kato also teaches solidifying the carbon and synthetic resin mixture (column 5, lines 9-10) and the presence of filaments (column 5, line 46).

14. The examiner notes that claims 34 and 37 appear to be product-by-process claims. "Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps". See MPEP § 2113. Therefore because all of the structure recited in claims 34 and 37 are present in the Kato reference, claims 34 and 37 are included in the above 102(b) rejection.

15. Claims 13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Campbell et al. U.S. Patent No. 5,863,673 hereinafter referred to as Campbell et al.

16. In reference to claim 13 Campbell et al. teaches a diffusion layer with at least a base layer that is made from a carbonized yarn woven fabric (column 2, lines 19-26), a conductive synthetic resin binder impregnated into the yarn (column 2, lines 53-54) and that the binder is not carbonized and is solidified (column 3, lines 1-2 and column 4, lines 13-21). It is inherent that a binder that is impregnated into a woven yarn would connect the filaments of the yarn together.

17. In reference to claim 16 Campbell et al. teaches the above structural features as well as the base layer having water-repellent characteristics (column 3, lines 65-67 and column 4, lines 1-7) and the use of a non-conductive synthetic resin binder (column 6, line 67, column 7, lines 1-3 and Table 2).

18. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Beattie et al U.S Patent No. 6,667,127 hereinafter referred to as Beattie et al.

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19. Beattie et al. teaches a diffusion layer with at least a base layer that is made from a non-woven carbon paper made from carbon fibers (column 6, lines 56-57), a synthetic carbonized resin binder that is non-uniformly impregnated therein (column 6, lines 63-67, column 8, lines 66-67, column 8, line 51 and column 9, line 31), that the layers on the base layer would be differing in the amount binder used (column 9, lines 56-64 and claim 33) and a rigid portion of the base layer would be present (column 9, lines 61-62 and column 11, line 13).

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hodge whose telephone number is (571) 272-2097. The examiner can normally be reached on 8:00am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RWH 5-12-05

MICHAEL BARR
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Michael Barr', with a long horizontal flourish extending to the right.